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12/23/2003

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EXAMINER

SEE, CAROL A

ART UNIT

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11/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

1. The following is repeated from the previous advisory action mailed 10/14/2008:

Examiner acknowledges amendment of claims 10-12 in Arguments/Remarks filed 9/2/2008.

Continuation of 11. does NOT place the application in condition for allowance because:

Argument: Examiner rejected claim 10 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant amended and asserted the meaning of amended claim 10 is clear. The element "responsive to a proposed postings of revenue, determining whether a revenue calculation of any control objects addresses the proposed posting" identifies those control objects that would use the proposed postings of revenue in a revenue calculation. The Examiner is referred to FIG. 3 and paragraphs 19-23 for an illustration of an embodiment of the claimed invention.

Response: According to MPEP 2106(II)(c), while it is appropriate to use the specification to determine what applicant intends a term to mean, a positive limitation from the specification cannot be read into a claim that does not itself impose that limitation. Here, the claim language "addresses" a proposed posting, it does not indicate that the posting is used in a calculation. Applicant's claimed meaning cannot be ascertained from the wording of the claim. Accordingly, Examiner maintains the rejection under 35 USC 112, 2nd paragraph.

Declaration under 37 C.F.R. 1.131

2. The following information is supplemental to the previous advisory action filed on 10/14/2008.

3. The Affidavits and exhibits filed on September 2, 2008 (clearer copy of one exhibit submitted November 6, 2008) under 37 CFR 1.131 have been considered but are ineffective to overcome the SAPR3 reference (www.sap.com/belux/industries/publicsector/pdf/BWP_functions_detail.pdf) (hereinafter www.sap.com).

In order to effectively swear behind the SAPR3 reference, the Affidavits and exhibits filed on September 2, 2008 under 37 CFR 1.131 must either: 1) show actual reduction to practice before June 2003; or where there has not been reduction to practice prior to the date of the reference, 2) establish conception of the invention prior to the effective date of the SAPR3 reference (June 2003) coupled with due diligence from prior to the reference date up to a subsequent (actual) reduction to practice or up to the date of filing of an application (constructive reduction to practice). See MPEP 715.

It appears Applicant is attempting to swear behind the SAPR3 reference by showing, in the 37 CFR 1.131 Affidavits, 1) actual reduction to practice prior to the effective date of the reference or alternatively, 2) conception of the invention (November 28, 2002) prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent actual reduction to practice. Conception and diligence up to a constructive reduction to practice – filing an application – is not

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addressed, as Applicant has not presented arguments regarding diligence up to 12/23/2003, Applicant's filing date of patent application.

Reduction to practice may be an actual reduction to practice or a constructive reduction to practice (i.e., the filing of a patent application). In the present case, Applicant is attempting to establish actual reduction to practice before the June 2003 reference. Establishing actual reduction to practice for a process requires all of the steps of the claimed process to have been successfully performed. See MPEP 2138.05. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the June 2003 reference. The Affidavits and exhibits have not persuasively shown the inventor(s) successfully performed all of the steps of at least the independent claims prior to June 2003. In particular, taking independent method claim 10 for example, the evidence fails to show the successful performance of blocking a posting from being admitted prior to June 2003. A claimed process, to meet the reduction to practice standard, has to actually be successfully performed. The Affidavits and exhibits have not persuasively shown the inventor(s) successfully performed all of the steps of at least the independent claims prior to June 2003 and thus, Applicant has not effectively sworn behind the June 2003 reference. Further, with regard to the system claim, the Affidavits and exhibits do not show rejecting a new revenue transaction (claim 6). At best, the Affidavits and exhibits show evidence of a presentation and invitation to meetings about a presentation.

In conclusion, the Affidavits and exhibits filed on September 2, 2008, under 37 CFR 1.131 have been considered but are ineffective to overcome the SAPR3 reference (June 2003). Accordingly, Examiner's previous rejections (filed 5/30/2008) remain.

Regarding item 2) above, concerning conception and diligence, although Applicant presents information regarding diligence from conception to actual reduction to practice, the actual showing required, if reduction to practice prior to the reference date is not shown, is diligence from prior to the reference date to actual reduction to practice or constructive reduction to practice, either of which occurs subsequent to the date of the applicable reference. In this case, according to Applicant assertion #3 of the Affidavit (filed 9/2/2008), an actual reduction to practice is asserted on January 16, 2003, prior to the reference date, for which conception and diligence need not be proven. Nonetheless, Examiner presents additional arguments regarding conception and the showing of diligence below.

While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

The evidence submitted is sufficient, as explained below, to establish a conception (Nov. 28, 2002) for some limitations of the invention prior to the effective date of the SAPR3 reference (June 2003). In particular, Applicant presents exhibit A, a presentation of the content of the invention, which Applicant asserts was available on

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November 28, 2002 in addition to e-mails that also reference the PowerPoint presentation. With respect to establishing conception of the invention, 37 CFR 1.131 are sufficient to establish conception of the invention with respect to the noted parts of claims 6, 10 and 16, but fail to establish conception of the invention with respect to claims 7, 11, 15, 17, 18, 19 and 21. In order to establish conception of the invention, the exhibits and affidavits must show that the inventor(s) had conceived of each and every limitation of the claims. As per MPEP 2138.04, conception is established "when the invention is made sufficiently clear to enable one skilled in the art to reduce it to practice without the exercise of extensive experimentation." Thus, the Affidavits and exhibits persuasively show that the inventor(s) had conceived of each and every limitation of claims 6, 10 and 16, except as noted above, prior to June 2003, but do not persuasively show the inventor(s) had conceived of each and every limitation of claims 7, 11, 15, 17, 18, 19 and 21 prior to June 2003.

Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference and ends with the date of a reduction to practice, either actual or constructive. Examiner notes that the required period for diligence extends beyond the reference date where conception has occurred but reduction to practice has not occurred prior to the reference date. The evidence submitted is insufficient to establish diligence from conception to the date of reduction to practice (January 16, 2003). The evidence shows three e-mails after the asserted conception date and prior to the effective date of the SAPR3 reference (e-mails dated December 12, 2002 and Jan. 16, 2003, the asserted date of reduction to practice).

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However, there is no evidence of due diligence in between the asserted conception date, November 28, 2002, and the January 16, 2003 e-mail that Applicant asserts is a statement regarding completion of a working prototype (an actual reduction to practice). According to MPEP 2138.06, merely stating that there were no weeks or months that the invention was not worked on is not enough. In this case, merely stating that diligence was exercised over the approximately 7 week time period from November 28, 2002 to January 16, 2003 is not enough. MPEP 2138.06 also states that even a 2-day period lacking activity has been held to be fatal. The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses.

Accordingly, as discussed above, reduction to practice or conception of the invention coupled with due diligence must be established in order to swear behind the reference. Examiner has presented arguments related to conception and diligence, noting, however, that these concepts are relevant when reduction to practice prior to an effective reference date has not been established. Since Applicant has failed to persuasively establish reduction to practice prior to the effective date of the SAPR3 reference, Applicant has not effectively sworn behind the June 2003 reference. Further, Applicant's efforts to prove diligence are not sufficient, as explained above, to effectively swear behind the 2003 reference. Accordingly, Examiner's previous rejections (filed 5/30/2008) remain.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carol See whose telephone number is (571)272-9742. The examiner can normally be reached on Monday - Thursday 6:45 am - 5:15 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon, can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/THOMAS A DIXON/
Supervisory Patent Examiner, Art Unit 3696

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